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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,034	09/22/2003	Griscom Bettie III	15783	4995

7590 12/01/2006

Scully, Scott, Murphy & Presser  
400 Garden City Plaza  
Garden City, NY 11530

EXAMINER

CARR, DEBORAH D

ART UNIT PAPER NUMBER

1621

DATE MAILED: 12/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/670,034	<b>Applicant(s)</b> BETTLE ET AL.	
	<b>Examiner</b> Deborah D. Carr	<b>Art Unit</b> 1621	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 September 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-70 is/are pending in the application.
- 4a) Of the above claim(s) 11-34, 37-61, 64-67, 69 and 70 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 35, 62 and 68 is/are rejected.
- 7) ☒ Claim(s) 3-9, 36 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/2004</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election with traverse of Group I, claims 1-10, 35, 62-62 & 68 in the reply filed on 11 September 2006 are acknowledged. The traversal is on the ground(s) that it hasn't been proven the inventions are independent and distinct, the search as a whole would not be a burden on the examiner and the criteria for which the Commissioner bases restriction practices is inadequate. This is not found persuasive because it has to be shown that the inventions or groupings are independent or distinct. (See previous office action) While applicant may not agree with the basis for determining a restriction requirement, the Commissioner as a valid tool recognizes it when multiple inventions are contained in a single application.

The requirement is still deemed proper and is therefore made FINAL.

2. It has been noticed claim 36 has been amended to read on claim 35 which is included in the elected group, this claim will be examined with Group I.

3. Claims 11-34, 37-61, 64-67, 69-70 withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 11 September 2006.

### *Claim Rejections - 35 USC § 102*

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4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. Claims 1-2, 35 rejected under 35 U.S.C. 102(a) as being clearly anticipated by Chang et al.

Chang et al. teaches a ceramide library containing tertiary amides that read in the instant compounds. As shown on page 1856 are the core used to produce said amide derivatives. The actual compounds reading on the instant invention are shown in the Chem. Abstr. of the article.

6. Claims 1-2, 10 rejected under 35 U.S.C. 102(b) as being clearly anticipated by JP-05/163203.

JP'203 teaches fatty acid containing tertiary amides that read in the instant compounds. The actual compounds reading on the instant invention are shown in the Chem. Abstr. of the publication.

7. Claims 1-2, 35, 62-62, 68 rejected under 35 U.S.C. 102(b) as being clearly anticipated by Shroot et al. (US Pat. 4,877,789).

US'789 teaches fatty acid containing tertiary amides that read in the instant compounds and their inclusion in mixtures, see cols. 1-2 & 7.

***Allowable Subject Matter***

8. Claims 3-9, 36 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah D. Carr whose telephone number is 571-272-0637. The examiner can normally be reached on Monday-Friday 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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ddc

A handwritten signature in black ink, appearing to read "Deborah D. Carr". The signature is fluid and cursive, with the first name "Deborah" being more prominent than the last name "Carr".

**DEBORAH D. CARR  
PRIMARY EXAMINER**